

## **REMARKS**

Claims 1, 17 and 33-47 have been amended. No claims have been added or cancelled. Therefore, claims 1-47 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Double Patenting Rejection:**

The Examiner rejects claims 1-47 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-31, 33-47, and 49-72 of co-pending Application No. 09/653,227. Applicants respectfully traverse this rejection on the grounds that the Examiner has not stated a proper *prima facie* rejection.

The only support given by the Examiner for the rejection is that “both applications are claiming [a] method for accessing a service in a distributed computing environment in which a client request[s] capability credentials to access [a] portion of a service through advertisement.” However, simply because claims in both applications recite some overlap in subject matter is not a proper reason for holding the claims of the present application obvious from the claims of the listed application. According to MPEP 804.II.B.1, “the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection.” This section of the MPEP also states that the same “factual inquires ... that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are employed when making an obviousness-type double patenting analysis.” MPEP 804.II.B.1 also states that the Examiner should list the differences between **each** rejected claim and the claims of the other patent/application, and for **each** difference the Examiner should give the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim is an obvious variation of the invention defined in a claim of the other patent/application. Simply stating that the claims of both applications recite some overlap in subject matter is not a valid reason why a person of ordinary skill in the art

would conclude that the invention defined in each claim of the present application is an obvious variation of the invention defined in a claim of the other patent/application. Nor has the Examiner specifically addressed **each difference** of **each claim** of the present application compared to the claims of the other application. Instead, the Examiner improperly lumped all the claims together and did not address each specific difference. The Examiner clearly has not met the requirements stated in MPEP 804.II.B.1 to establish a *prima facie* obviousness-type double patenting rejection. Accordingly, Applicants respectfully request removal of the double patenting rejection of claims 1-47.

### **Section 102(a) Rejection:**

The Examiner rejected claims 1, 2, 5, 6 and 9-16 under 35 U.S.C. § 102(a) as being anticipated by Adams (U.S. Patent 6,718,470). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, Adams fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Adams teaches a system for granting security privileges by providing test criteria data so that security privilege certificates (or other authorization credentials) may be selected from among multiple subscriber privilege data. Adams teaches that certificates, such as Kerberos tickets, privilege attribute certificates, or other public key certificates (Adams, column 7, lines 48-55) may be selected from among multiple privilege data based on test criteria supplied by a relying unit (such as a software application, computer node or other entity). A selector entity may search a common repository of security privilege certificates. The selector entity then returns any and all privilege data that meets the test criteria data. Thus, the selector unit may return multiple certificates, each of which meets the test criteria data. (see, Adams, column 3, lines 26-59; column 4, lines 25-36; and column 5, lines 18-46). Adams does not mention anything about a selecting and returning a certificate that indicates a subscriber unit (client) has the right to use *only* an indicated portion of a service's capabilities. Instead, Adams states that

any matching attribute certificates are sent as privilege data (Adams, column 6, lines 65-67). The certificates in Adams do not indicate that a client has the right to use *only* a portion of a service's capabilities. In fact, no mention is made of allowing access to only a portion of a service's capabilities.

Applicants remind the Examiner that anticipation requires the presence in a single prior art reference disclosure of each and every limitation of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Adams fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Therefore, Adams clearly cannot be said to anticipate claim 1.

Thus, for at least the reasons above, the rejection of claim 1 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks apply to claims 17 and 33 as well.

Regarding claim 5, Adams fails to disclose the client receiving an advertisement for the first service, wherein the advertisement describes the portion of the first service's capabilities. The Examiner admits that Adams makes "no specific mention of the advertisement" but asserts, "advertisement serves as a way of letting the user be aware of the service[s] available." The Examiner has clearly failed to provide a proper rejection of claim 5. By admitting that Adams does not disclose the use of an advertisement, the Examiner has clearly admitted that Adams fails to anticipate claim 5. The Examiner's statement regarding how advertisements may serve as a way of letting a user know what services are available has absolutely no bearing on the fact that Adams fails to disclose anything about an advertisement for a service that describes a portion of the service's

capabilities. The fact that Adam's system might benefit from the use of such an advertisement, as suggested by the Examiner, is irrelevant to a rejection based on anticipation (i.e. § 102). The Examiner's statement is also unsupported by any evidence of record.

As the Examiner is surely aware, a claim is "anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (M.P.E.P. § 2131). As admitted by the Examiner, Adams fails to disclose the use of an advertisement. Moreover, the Examiner has not shown that the use of advertisements is inherent in Adams' system. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence" and "[s]uch evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference" (emphasis added, M.P.E.P. § 2131.01 III). As noted above and admitted by the Examiner, Adams makes no mention of advertisements, nor has the Examiner provided any evidence showing that advertisements are *necessarily present* in Adams' system. Instead, the Examiner has merely concluded that the use of an advertisement might be beneficial, which as stated above, is completely speculative and irrelevant. The Examiner is merely using hindsight speculation, which is clearly improper.

Additionally, Adams fails to disclose that a client's indication of the set of desired capabilities comprises an indication of the advertisement. As noted above, Adams fails to mention anything about advertisements, as admitted by the Examiner. Furthermore, Adams does not mention anything about a client indicating a set of desired capabilities as part of requesting a capability credential, *where the indication of the set of desired capabilities includes an indication of an advertisement for a service*. As noted above, the Examiner has merely stated that the use of advertisements would be beneficial to Adams' system without showing that Adams' system actually includes the use of advertisements. The Examiner has not provided any argument, explanation, or evidence showing that Adams' system includes a client indicating a set of desired capabilities, where that

indication includes an indication of an advertisement for a service providing those capabilities.

The Examiner cites column 6, lines 31-67 of Adams and states, “the subscriber wants to access the relying party’s service, but has to request [a] credential from the centralized privilege data selector by submitting the subscriber’s identity and the relying party’s identifier.” Thus, the cited passage only mention that a subscriber includes an identification of the relying party, but makes no mention of any indication of an advertisement that describes a portion of the first service’s capabilities. Furthermore, the cited passage only teaches that Adams’ subscriber unit includes the relying party’s identifier when requesting a security certificate. The cited passage makes no mention of the client including an indication of an advertisement for a service as part of an indication of a set of desired capabilities, as required by Applicants’ claim 5. Nor does the Examiner mention anything about Adams’ subscriber including an indication of an advertisement for the service when indicating a set of desired capabilities.

Thus, for at least the reasons above, the rejection of claim 5 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks also apply to claims 21 and 37.

Regarding claim 6, contrary to the Examiner’s assertion, Adams fails to disclose where the indication of the advertisement is the advertisement itself. The Examiner cites column 5, lines 14-18. However, the cited portion of Adams makes no mention of any indication of an advertisement, nor that such an indication of an advertisement is the advertisement itself. Instead, the cited passage states that a subscriber unit may communicate a request over a global network link to a website of a relying party requesting access to another application controlled by the relying party to facilitate a financial transfer. The cited passage provides no support for the Examiner’s rejection of claim 6. Furthermore, in the rejection of claim 5, the Examiner admits that Adams makes no mention of advertisements. Thus, the Examiner has failed to make a proper rejection

of claim 6. The rejection of claim 6 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks also apply to claims 22 and 38.

Regarding claim 9, Adams does not disclose an advertisement that is a protected advertisement that describes the first service's capabilities but does not provide an interface to the first service's capabilities. The Examiner cites column 5, lines 14-18 where Adams teaches that a subscriber unit may send a request message to a website of a relying party to request access to another application controlled by the relying party to facilitate a financial transfer. As noted above regarding the rejection of claim 6, the cited passage makes no mention of any advertisements of any kind.

The Examiner argues, "the website describes the service, and the service can be provided upon authentication." However, the Examiner is clearly speculating regarding the workings of Adams' system. Adams does not mention that the website describes any service provided by the relying party. The Examiner's speculation regarding the website is improper and irrelevant in a rejection based on anticipation. Additionally, the Examiner is ignoring the specific limitations (in claim 5, from which claim 9 depends) regarding the client *receiving the advertisement* for the service and regarding where the client's indication of a set of desired capabilities *includes an indication of the advertisement*. The cited passage only mentions that a subscribing unit may send a request to a website. Adams does not mention anything about the subscribing unit including an indication of any website in an indication of a set of desired capabilities, as would be required according to the Examiner's rejection of claim 9.

Thus, the rejection of claim 9 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks also apply to claims 25 and 41.

Applicants also assert that numerous other ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be

unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

### **Section 103(a) Rejections:**

The Examiner rejected claims 3 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Adams, and claims 17-23, 25-39 and 41-47 as being anticipated by Adams under 35 U.S.C. § 102(a) or as being unpatentable over Adams in view of Czerwinski under 35 U.S.C. § 103(a). Applicants respectfully traverse these rejections for at least the reasons presented below.

Regarding the § 102(a) rejection of claims 17 and 33, as noted above regarding the § 102 rejection of claim 1, Adams fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Please refer to the remarks above regarding the rejection of claim 1 for a more detailed explanation regarding why Adams fails to anticipate claim 1, which apply with equal force to the § 102 rejection of claims 17 and 33.

Regarding the alternative § 103(a) rejection of claims 17 and 33, the Examiner has failed to provide a proper rejection. The Examiner states, "claims 17-23, 25-39, and 41-47 encompass the same scope as claims 1-7 and 9-16" and that "claims 17-23, 25-39, and 41-47 are rejected based on the same reasons set forth in rejecting claims 1-7 and 9-16." However, claims 1-7 and 9-16 are not rejected under § 103(a) as being unpatentable over Adams in view of Czerwinski. Thus, the Examiner has failed to provide a proper § 103(a) rejection of claims 17 and 33.

It has been very well established that to establish a *prima facie* case of obviousness (e.g. a proper § 103(a) rejection) three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference(s) must teach or suggest all the claim limitations. (See, M.P.E.P. § 2143). The Examiner has not met any of the three basic requirements of a proper § 103(a) rejection of claims 17 and 33. Furthermore, the Examiner “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” If the Examiner does not produce a *prima facie* case, “the applicant is under no obligation to submit evidence of nonobviousness.” (see, M.P.E.P. § 2142).

Applicants also note that deficiencies of Czerwinski in regard to independent claims 17 and 33 are discussed in Applicants’ previously filed Appeal Brief from which the Examiner reopened prosecution with the current rejection. For the reasons stated above in regard to Adams and the reasons stated in the previous Appeal Brief in regard to Czerwinski, it is clear that neither Adams nor Czerwinski, alone or in combination, teaches or suggests all the limitations of independent claims 17 and 33.

Thus, for at least the reasons presented above, the rejection of independent claims 17 and 33 is not supported by the cited art and removal thereof is respectfully requested.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

**Allowable Subject Matter:**

Claims 8, 24 and 40 were objected to as being dependent upon a rejected base claim, but otherwise allowable if rewritten in independent form. In light of the above remarks, Applicants assert that these claims are in condition for allowance in their present form.

## CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-70400/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address

Respectfully submitted,



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